



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Köster *et al.*
Serial No.: 09/355,705
Confirmation No.: 6820
Filed: November 5, 1999
For: A REVERSIBLE STOICHIOMETRIC
PROCESS FOR CONJUGATING
BIOMOLECULES
Group Art Unit: 1634
Examiner: Sisson, B.

I hereby certify that this paper and the attached papers are being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 2327, Arlington, VA 22202, on this date.

08/16/02
Date

Rita H. Jennings
Rita Jennings

TRANSMITTAL LETTER

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

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AUG 22 2002
TECH CENTER 1600/2900

Sir:

Transmitted herewith is a Petition under 37 C.F.R. §1.144 - Petition from Requirement for Restriction for filing in connection with the above-identified application.

- ☒ The Commissioner is hereby authorized to charge any fee that may be due in connection with this and the attached papers or with this application during its entire pendency to Deposit Account No. 50-1213. A duplicate of this sheet is enclosed.

Respectfully submitted,
HELLER EHRMAN WHITE & McAULIFFE LLP

By:

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#21
~~Handwritten signature~~
Rita Jennings

THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PETITION UNDER 37 C.F.R. §1.144
PETITION FROM REQUIREMENT FOR RESTRICTION

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

Applicant hereby petitions under 37 C.F.R. §1.144 from a Restriction Requirement in the above-captioned national stage application. Applicant requests removal of the Requirement as between Groups I and IV, or alternatively as between Groups I and V, or alternatively as between Groups I and VI. Therefore, Applicant respectfully requests that Groups I and IV, or alternatively Groups I and V, or alternatively Groups I and VI, be examined in the instant application. It is respectfully submitted that Groups I and IV, and Groups I and V, and Groups I and VI, do not lack unity of invention within the meaning of PCT Rule 13 because Group I is directed to a product and a process for the manufacture of the product, while each of Groups IV, V and VI are directed to uses of the product. Therefore, one of Groups IV, V and VI should be rejoined with Group I and examined in the instant application.

STATEMENT OF FACTS

The above-captioned application is a national stage application of International Application No. PCT/US98/02007, in accordance with 35 U.S.C. §371. Therefore, the Lack of Unity standard under the PCT, not restriction practice under U.S. rules, applies to this application. The Lack of Unity Objection was set forth in a written Objection, mailed October 2, 2001. The Objection set forth six (6) Groups for election. Applicant elected, with traverse, Group I, and requested reconsideration of the Objection as between Groups I and IV, and as between Groups I and V, and as between Groups I and VI, in the Election and Amendment, mailed January 2, 2002. Applicant's arguments were not deemed persuasive. The Lack of Unity Objection was made final in an Office Action, mailed June 17, 2002.

ARGUMENT

Applicant respectfully petitions for reconsideration and removal of the Objection as between Groups I and IV, or alternatively as between Groups I and V, or alternatively as between Groups I and VI, in view of the following remarks. The Office Action, mailed June 17, 2002, urges that the Objection is based on the allegation that all of the groups presented, not just some of them, must be so linked as to have unity of invention. Applicant respectfully disagrees. Even assuming *arguendo* that some of the Groups (such as Groups II and III) lack unity of invention with Group I, the Office is not allowed to maintain improper lack of unity objections. Applicant respectfully submits that Groups I and IV, and Groups I and V, and Groups I and VI, do not lack unity of invention for the reasons set forth in detail below.

As noted above, this application is the U.S. national stage of International Patent Application No. PCT/US98/02007, in accordance with 35 U.S.C. §371. As stated in MPEP 201, national stage applications of international applications are similar to national applications, but there are differences. Among these differences is inapplicability of restriction practice to national stage applications.

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Restriction practice is applied to national applications, but unity of invention practice is applied to national stage applications (see, MPEP 201 and MPEP 1893.03(d)).

Lack of Unity Standard

When the U.S. Patent Office considers an international application **during the national stage**, restriction must be based on unity of invention, which is governed by PCT Rule 13 (see MPEP 1893.03(d); Caterpillar Tractor Co. v. Commissioner of Patents and Trademark, 650 F. Supp. 218, 31 USPQ 590 (E.D. Virginia, 1986); In re Caterpillar Tractor Co., 228 USPQ 77). In the Caterpillar cases it was ultimately held that the language in Rule 13.1 "specially adapted" is not to be interpreted as meaning that the process of manufacture can only be used to manufacture the product because this interpretation is in conflict with the PCT Rule, which provides that no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided in the Treaty (Article 27 of the PCT). Thus, the U.S. Patent Office cannot impose requirements that differ from those provided in the Treaty. Since restriction practice differs from and is more restrictive than unity of invention, the unity of invention rules must govern.

Therefore, it is respectfully submitted, and it appears that the Office has acknowledged, that the rules of unity of invention (PCT Rule 13.1 and 37 C.F.R. §1.475) apply to this application. Rule 13.1 requires that an international application shall relate to one invention only or to a **group of inventions so linked as to form a single general inventive concept**.

PCT Rule 13

It is respectfully submitted that Groups I and IV, and Groups I and V, and Groups I and VI, relate to (i) a product and a process for the manufacture of said product (Group I), and (ii) a use of the said product (each of Groups IV, V and VI), and therefore do not lack unity of invention under PCT Rule 13. It is

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therefore respectfully requested that Groups I and IV, or alternatively Groups I and V, or alternatively Groups I and VI, be examined in the instant application.

Groups I and IV

Group I is directed to a composition and a method of preparing the composition. Group IV is directed to a method of purification using the composition of claim 44. Claim 44 is in Group I. Such groups of claims do not lack unity of invention under PCT Rules 13.1 and 13.2. See 37 CFR §1.475(b):

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

...

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...

The claims of Group IV are directed to a use of the composition of Group I (a method of purification), and the claims of Group I are directed to a product and a process specially adapted for the manufacture of the product (a process for preparing the composition of claim 1). Such Groups of claims do not lack unity of invention, and therefore should be examined in one application.

Applicant respectfully requests reconsideration of the lack of unity objection as between Groups I and IV. In view of Applicant's election of Group I herein, it is respectfully requested that the claims of Groups I and IV, *i.e.*, claims 1-19, 44-49 and 53-56, be examined in the instant application.

Groups I and V

Group I is directed to a composition and a method of preparing the composition. Group V is directed to a method of sequencing using the composition of claim 44. Claim 44 is in Group I. Such groups of claims do not lack unity of invention under PCT Rules 13.1 and 13.2. See 37 CFR §1.475(b):

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

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...

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...

The claim of Group V is directed to a use of the composition of Group I (a method of sequencing), and the claims of Group I are directed to a product and a process specially adapted for the manufacture of the product (a process for preparing the composition of claim 1). Such Groups of claims do not lack unity of invention, and therefore should be examined in one application.

Applicant respectfully requests reconsideration of the lack of unity objection as between Groups I and V. In view of Applicant's election of Group I herein, it is respectfully requested that the claims of Groups I and V, *i.e.*, claims 1-19, 44-47, 50 and 53-56, be examined in the instant application.

Groups I and VI

Group I is directed to a composition and a method of preparing the composition. Group VI is directed to a method of genetic or expression profiling using the composition of claim 44. Claim 44 is in Group I. Such groups of claims do not lack unity of invention under PCT Rules 13.1 and 13.2. See 37 CFR §1.475(b):

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

...

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...

The claim of Group VI is directed to a use of the composition of Group I (a method of genetic or expression profiling), and the claims of Group I are directed to a product and a process specially adapted for the manufacture of the product (a process for preparing the composition of claim 1). Such Groups of claims do not lack unity of invention, and therefore should be examined in one application.

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Applicant respectfully requests reconsideration of the lack of unity objection as between Groups I and VI. In view of Applicant's election of Group I herein, it is respectfully requested that the claims of Groups I and VI, *i.e.*, claims 1-19, 44-47, 51 and 53-56, be examined in the instant application.

* * *

In view of the above, reconsideration and removal of the lack of unity objection as between Groups I and IV, or alternatively as between Groups I and V, or alternatively as between Groups I and VI, are respectfully requested.

Respectfully submitted,
HELLER EHRMAN WHITE & McAULIFFE LLP

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